

TTAB

M&G 7780.907LISTA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3M Company, )  
)  
Opposer, )  
)  
v. )  
)  
Sachen Chandaria, )  
)  
Applicant. )  
\_\_\_\_\_ )

Opposition No.: \_\_\_\_\_

Mark: **EDIT-IT**

Serial No.: 76/489,528

Filing Date: February 14, 2003

Published: October 21, 2003



11-17-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

**NOTICE OF OPPOSITION**

3M Company, a Delaware corporation located at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55114, believes that it will be damaged by registration of the mark EDIT-IT shown in trademark application Serial No. 76/489,528, filed February 14, 2003, by Sachen Chandaria, published in the *Official Gazette* on October 21, 2003, and hereby opposes the same. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant seeks to obtain under the provisions of the Trademark Act, registration on the Principal Register of the designation EDIT-IT as a trademark for "memo pads with replaceable sheets having adhesive backing thereon," in International Class 16.

2. Opposer is in the business of manufacturing and selling tape products, including stationery notes and note pads containing adhesive on one side ("Repositionable Note Products").

3. Opposer is the owner of the mark POST-IT, having adopted and used said mark on or in connection with stationery products including Repositionable Note Products, and in the marketing and sale thereof in interstate commerce since at least as early as 1974.

4. Opposer owns numerous registrations for its POST-IT mark, including the following (collectively referred to herein as "Opposer's POST-IT Marks"):

Mark	Reg. No./ Reg. Date	Filing Date	Use Date	Goods
POST-IT	1,046,353 Aug. 17, 1976	Dec. 29, 1975	Sept. 25, 1974	Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place.
POST-IT	1,198,694 June 22, 1982	Mar. 12, 1981	Sept. 25, 1974	Stationary notes containing adhesive on one side for attachment to surfaces
POST-IT	1,208,297 Sept. 14, 1982	Nov. 19, 1981	Oct. 1, 1981	Trays for holding stationery notes
POST-IT	1,284,295 July 3, 1984	June 30, 1983	Jan. 1, 1983	Adhesive tape for home and office use.
POST-IT	1,718,114 Sept. 22, 1992	Feb. 27, 1992	Oct. 5, 1989	Stickers.
POST-IT	2,012,212 Oct. 29, 1996	Nov. 12, 1993	Feb. 16, 1996	Computer software for creating notes and annotations.
POST-IT	1,935,381 Nov. 14, 1995	Nov. 14, 1994	May 24, 1994	Adhesive backed easel paper and easel pads.
POST-IT and Design	2,402,722 Nov. 7, 2000	Dec. 22, 1998	Aug. 27, 1999	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; glue sticks for stationery or office use; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other vertical surfaces to hold displays or other messages in place.

Mark	Reg. No./ Reg. Date	Filing Date	Use Date	Goods
POST-IT and Design	2,402,723 Nov. 7, 2000	Dec. 22, 1998	Aug. 27, 1999	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; glue sticks for stationery or office use; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other vertical surfaces to hold displays or other messages in place.
POST-IT and Design	2,371,084 July 25, 2000	Sept. 1, 1999	July 16, 1999	Computer software for creating notes and annotations.
POST-IT and Design	2,372,832 Aug. 1, 2000	Sept. 1, 1999	July 16, 1999	Computer software for creating notes and annotations.

5. The registrations listed in the above table have not been canceled, are valid, and are now in full force and effect.

6. The following registrations are incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065: 1,046,353; 1,198,694; 1,208,297; 1,284,295; 1, 718,114; 2,012,212; and 1,935,381. Consequently, these registrations are conclusive evidence of the validity of the registered marks and of the registration of the marks, of Opposer's ownership of the marks, and of Opposer's exclusive right to use the registered marks in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

7. Opposer has advertised and promoted its POST-IT Marks extensively. Opposer has also made substantial sales of products under said marks. As a result of such use and promotion, Opposer's POST-IT Marks have developed and represent valuable goodwill inuring to the benefit of Opposer.

8. Opposer's POST-IT Marks are famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and became famous before Applicant commenced use of Applicant's EDIT-IT mark.

9. Opposer has priority with respect to the mark at issue in this opposition. Opposer adopted and commenced use of the term POST-IT as a trademark long before Applicant adopted the EDIT-IT mark. Opposer's usage of the POST-IT Marks commenced at least as early as 1974, twenty-eight (28) years prior to Applicant's filing date of its application. Opposer owns registrations that registered more than twenty-six (26) years before the filing date of Applicant's application.

10. Upon information and belief, Applicant had knowledge of the fact that Opposer used the term POST-IT as a trademark for Repositionable Note Products before it adopted the EDIT-IT mark.

11. In addition to the application being opposed in this opposition, Applicant has also filed the following applications to register marks that include the term "IT" for Repositionable Note Products:

<b>Mark</b>	<b>Serial No.</b>	<b>Filing Date</b>	<b>Goods in Class 16</b>
EYE-IT	76/185,552	Dec. 22, 2000	Memo pads with a self-adhesive backing thereon
SIGN-IT	76/256,251	May 14, 2001	Memo pads and adhesive tapes for school, home and office use
SEAL-IT GOLD TAPE	76/273,006	June 18, 2001	Adhesive tape for packaging, stationery, home and office use and memo pads, namely, removable and replaceable memo pads

<b>Mark</b>	<b>Serial No.</b>	<b>Filing Date</b>	<b>Goods in Class 16</b>
SEAL-IT SILVER TAPE	76/273,007	June 18, 2001	Adhesive tape for packaging, stationery, home and office use and memo pads, namely, removable and replaceable memo pads
SEAL-IT BRONZE TAPE	76/273,008	June 18, 2001	Tape for packaging, stationery home and office use and removable and replaceable memo pads
DRAFT IT	76/478,328	Dec. 26, 2002	Memo pads with self-adhesive backing thereon
READ-IT	76/489,527	Feb. 14, 2003	Memo pads and pads with a reusable and replaceable self-adhesive backing

12. Upon information and belief, Applicant is related to, affiliated with, and/or working with Conros Corporation, a Canadian corporation. Conros Corporation, through Applicant's counsel, Joseph A. Sebolt, Sand & Sebolt, has filed the following applications to register "IT" marks for Repositionable Note Products:

<b>Mark</b>	<b>Serial No.</b>	<b>Filing Date</b>	<b>Goods in Class 16</b>
SEAL-IT and Design	76/150,617	October 23, 2000	Stationery for household and office use; removable memo pads and replaceable memo pads
SEAL-IT	76/150,624	Oct. 23, 2000	Stationery for household and office use; removable memo pads and replaceable memo pads
IT and Design	76/150,987	Oct. 23, 2000	Adhesive tape for household or stationery use; removable and replaceable memo pads

13. Opposer also notes that Conros Corporation filed an application to register the mark YELLOW NOTE (Serial No. 76/144,984, filed October 12, 2000) for self-adhesive notes. This mark was found to be confusingly similar by the Examining Attorney handling the application with Opposer's registration for the color canary yellow applied to Repositionable Note Products (Registration No. 2,390,667).

14. Applicant also filed four additional applications to register marks owned by Opposer for tape products. Opposer owns the marks 810 and 6200 for adhesive tape products. Sachen Chandaria filed Application Serial No. 76/175,129 for the mark 6200; Serial

No. 76/175,128 for the mark SIXTY TWO HUNDRED; Serial No. 76/175,127 for the mark EIGHT-TEN; and Serial No. 76/175,126 for the mark 8-10.

15. Applicant, Sachen Chandaria, and Conros Corporation have adopted and sought to register a number of marks that they know to be owned by Opposer with the intent of trading on the goodwill of Opposer and diluting Opposer's trademark rights, all to the damage of Opposer.

16. Applicant's EDIT-IT mark is confusingly and deceptively similar to Opposer's previously used and duly registered POST-IT Marks.

17. The Repositionable Note Products listed in Opposer's POST-IT registrations are identical to the "memo pads with replaceable sheets having adhesive backing thereon " listed in Class 16 of Applicant's application for registration of the EDIT-IT mark. These products are directly competitive with each other.

18. Upon information and belief, the Repositionable Note Products listed in Opposer's POST-IT registrations and Applicant's EDIT-IT mark are promoted and sold in the same channels of trade to the same consumers or class of consumers.

19. Applicant's EDIT-IT mark is similar in sight, sound and commercial impression to Opposer's POST-IT Marks.

20. Due to the similarity between Applicant's claimed mark, EDIT-IT, and Opposer's previously used and duly registered POST-IT Marks, the related nature of the Repositionable Note Products of the respective parties, customers and potential customers are likely to believe that Applicant's products originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

21. The use and registration by Applicant of the mark EDIT-IT for Applicant's "memo pads with replaceable sheets having adhesive backing thereon " is likely to cause

confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used and duly registered POST-IT Marks, again resulting in damage to Opposer.

22. Because of the related nature of the goods, and the similarity of the marks, use and registration of the term EDIT-IT by Applicant for "memo pads with replaceable sheets having adhesive backing thereon" is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer for use with Opposer's products causing further damage to Opposer.

23. Applicant's use and registration of the EDIT-IT mark for "memo pads with replaceable sheets having adhesive backing thereon" is likely to dilute the distinctive quality of Opposer's famous POST-IT Marks, again resulting in damage to Opposer.

24. If Applicant is granted registration of the mark herein opposed for Repositionable Note Products, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer.

25. Registration of the mark shown in Application Serial No. 76/489,528 for "memo pads with replaceable sheets having adhesive backing thereon" will result in damage to Opposer under the provisions of Sections 2(d) and 2(f) of the U.S. Trademark Act, 15 U.S.C. Sections 1052(d) and 1052(f), pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term EDIT-IT be refused.

Please direct all correspondence to:

Scott W. Johnston  
MERCHANT & GOULD P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-9944

Opposer herein appoints Paul A. Welter, Reg. No. 20,890; D. Randall King; John A. Clifford, Reg. No. 30,247; Linda M. Byrne, Reg. No. 32,404; John L. Beard, Reg. No. 27,612; Sandra Epp Ryan, Reg. No. 39,667; Scott W. Johnston, Reg. No. 39,721; Kristina M. Foudray, Anna W. Manville and Gregory C. Golla of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Accompanying the duplicate signed copies of this Notice of Opposition is the required fee of \$300.00. Please charge any excess fees for or credit any overpayment to the Deposit Account No. 13-2725 of Opposer's counsel noted below.

Respectfully submitted,

3M COMPANY

By its Attorney,

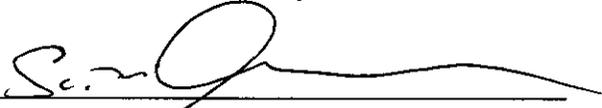


Date: 11-14-03

Scott W. Johnston  
MERCHANT & GOULD P.C.  
80 South Eighth Street, Suite 3200  
Minneapolis, Minnesota 55402-2215  
(612) 332-5300

CERTIFICATE OF MAILING

The undersigned hereby certifies that the foregoing NOTICE OF OPPOSITION, regarding U.S. Serial Number 76/489,528, is being deposited with the U.S. Postal Service by First Class Mail, in an envelope addressed to the Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513 on this 14th day of November, 2003.

  
\_\_\_\_\_  
Scott W. Johnston

# Merchant & Gould

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A Professional Corporation

3M Company, )  
Opposer, )  
v. ) Opposition No. \_\_\_\_\_  
Sachen Chandaria, )  
Applicant. )



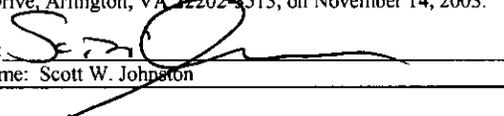
11-17-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Mark: EDIT-IT  
Serial No.: 76/489,528  
Docket Number: 7780.907USTA  
Official Gazette: October 21, 2003

Due Date: November 20, 2003  
Filing Date: February 14, 2003

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513, on November 14, 2003.

By:   
Name: Scott W. Johnston

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- Notice of Opposition (1 Original and 1 Copy)
- Check in the amount of \$300.00 to cover Filing Fee.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By:   
Name: Scott W. Johnston  
Reg. No. 39,721  
SWJ/skl

(CONTESTED MATTER)